



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,975	04/20/2001	Mark Buonanno	CSCO-3825	4882

7590 06/24/2005

WAGNER, MURABITO & HAO LLP
Third Floor
Two North Market Street
San Jose, CA 95113

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
----------	--------------

3639

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/839,975	Applicant(s) BUONANNO ET AL.	
	Examiner Igor Borissov	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3639

DETAILED ACTION

Response to Amendment

Amendment received on 4/4/2005 is acknowledged and entered. **Claims 1, 11 and 18** have been amended. **Claims 1-27** are currently pending in the application.

Claims Objections

Claims Objections have been withdrawn based on applicant's arguments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-14, 17-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elms et al. (US 2002/0072992).

Elms et al. (Elms) teaches a method, system and computer-readable medium containing instructions for enabling a host to facilitate a transaction between a first party and a second party, comprising:

As per claims 1, 11 and 18,

locating a first party (a buyer computer) and a second party (a vendor computer) [0020]; said buyer and vendor computers are configured to communicate via the Internet [0024];

establishing a real-time chat between the buyer and the vendor; said real-time chat includes a spoken dialog between the parties (while the voice communication is active) [0070];

Art Unit: 3639

establishing a web-based collaboration session (a real-time chat) through a website utility [0020] between the buyer and the vendor; said real-time chat includes a spoken dialog between the parties (while the voice communication is active) [0070]; transacting a business deal between the buyer and the vendor [0013]; [0083]; [0084].

Elms does not specifically teach that said transacting is conducted within the *business-to-business exchange*.

However, information as to *business-to-business exchange* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in would be performed the same regardless of the type of the exchange.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Elms to include that said transacting is conducted within the *business-to-business exchange*, because it would advantageously increase the application field of the Elms' invention, thereby bring more revenue.

Furthermore, Elms teaches:

As per claims 2, 12 and 19,

automatically completing a computer-to-computer transaction once the buyer's and the vendor's criteria are met [0020]; [0027].

As per claims 3, 13 and 20,

manually completing a transaction between the buyer and the vendor through the collaboration session [0030]; [0070].

As per claims 4, 14 and 21,

Art Unit: 3639

a call center agent facilitating a transaction between the buyer and the vendor upon request [0030].

As per claims 7, 17 and 24, Elms teaches said method and system, comprising the step of utilizing an agent (middlemen) to contact either the first party or the second party to complete a transaction when predetermined criteria for a prospective transaction is met [0030]; [0040]; [0041]; [0051].

Elms does not specifically teach that said agent is a *proactive* agent.

However, the specification does not provide any indication of the advantages of the "*proactive*" feature over the teachings of the prior art. Without such indication, it appears that the *proactive* agent is an obvious variation of the agent disclosed in Elms.

As per claim 8, said method and system, wherein the locating step includes seek-and-find technology [0020].

As per claim 9, said method and system, wherein the locating step includes instant messaging [0070].

As per claim 10, providing complete record of the correspondence between the parties and transaction signature [0069]; [0065]; wherein the correspondence includes the real-time chat by way of a spoken dialog between the parties [0070].

Claims 5-6, 15-16, 22-23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elms et al. in view of Walker et al. (US 2002/0169626).

As per claims 5, 15 and 22, Elms teaches providing complete record of the correspondence between the parties and transaction signature [0069]; [0065]; wherein the correspondence includes the real-time chat over the Internet by way of a spoken dialog between the parties [0070] and further includes audio and video communication [0026].

Elms does not explicitly teach that said audio and video communication over the Internet includes video conferencing.

Art Unit: 3639

Walker et al. (Walker) teaches a method and system for providing to a prospective customer a reference for a merchant, wherein communication between parties is enabled via video conferencing, instant messaging or e-mail [0091].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Elms to include video conferencing, as disclosed in Walker, because it would advantageously allow parties to see each other during said communication, thereby creating more relaxed and trustworthy environment for conducting business transaction.

As per claims 6, 16 and 23, Elms teaches providing the real-time chat over the Internet in written format between the parties [0070].

As per claims 25-27, Walker teaches providing video conferencing between the parties, thereby obviously indicating providing voice and video communication. The motivation to combine Elms with Walker would be to advantageously allow parties to see each other during said communication, thereby creating more relaxed and trustworthy environment for conducting business transaction.

Response to Arguments

Applicant's arguments filed on 4/4/2005 have been fully considered but they are not persuasive.

In response to Applicant's arguments that Elms fails to teach conducting a voice communication and a web-based collaborative session, the examiner points out that Elms explicitly teach this feature. Specifically, Elms teaches: establishing through a website utility a real-time chat between the buyer and the vendor, wherein said real-time chat includes a spoken dialog between the parties [0070]; [0020].

In response to Applicant's arguments that Elms fails to disclose conducting both the e-mail session and a voice communication between the parties, it is noted that Elms explicitly teach this feature. Specifically, Elms teaches: "In addition to the exchange of correspondence by email, the present invention provides for a real-time chat between

Art Unit: 3639

the buyer and vendor. The exchange could be by way of a spoken dialog between parties" [0070].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Hayes, can be reached at (571) 272-6708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

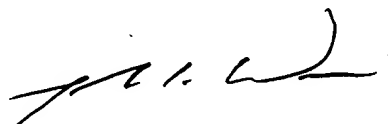
Washington D.C. 20231

or faxed to:

(703) 872-9306

[Official communications; including After Final
communications labeled "Box AF"]

IB
6/21/2005


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800